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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,300	09/11/2003	Masaya Ogura	03599.000076.	3570
5514 7590 11/28/2007 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			EXAMINER SKIBINSKY, ANNA	
			ART UNIT 1631	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/659,300

Applicant(s)

OGURA, MASAYA

Examiner

Anna Skibinsky

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 15-25 is/are pending in the application.
- 4a) Of the above claim(s) 2-7 and 15-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 8, and 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Applicants

Applicants amendments to claim 1 is acknowledged. Claims 1, 8, 9, 11 and 14 are under examination.

Applicants' response, filed 5/29/2007, has been fully considered. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

Claim Election/Restriction

Claims 2-7, 10, 12, 13 and 15-24 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Group and Species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on April 24, 2006.

Newly submitted claim 25 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claim 25 is withdrawn from examination as it pertains to the subject matter of the non-elected Groups III in the Election/Restriction requirement filed 3/22/2006.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution

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on the merits. Accordingly, claim 25 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 103

1. The following rejection is necessitated by amendments filed 5/29/2007.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Othmer et al. (US Patent No. 6,167,358) in view of Nova et al. (US Patent No. 6,329,139).

4. The instant claims recite a method for identifying the identification of a medical examination device, writing information related to its usage and correlating the identification of the device with the information related to its usage. The method then shares and utilizes the information about the device with relevant users.

5. Othmer et al. teach a system and method which can be applied to medical examination devices. The method includes detecting information about a computer based system and relaying it back to server which then communicates the information to a plurality of other computer based systems (Abstract).

6. Claim 1, lines 1-3 and 7-9 recites identifying the identification of a medical examination device and writing down information relating to the usage of the device in a memory.

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7. Othmer et al. teaches gathering information about a computer based system over a time interval and transferring the accumulated information back to a central server in order to generate statistics about the frequency of a problem (col. 2, lines 43-52). The system includes generating usage information for each feature in a software application (col. 2, lines 47-49).

8. Claim 1, lines 1-3 and 7-9 and claim 8 recite remotely, through the internet, writing down in memory the additional information related to the usage of the medical examination device.

9. Othmer et al. teaches the server connected remotely to the Internet that permits communication of the computer based systems (col. 4, lines 46-50). The information extracted from the computer based systems which can be medical examination devices such as blood glucose monitor or medical laboratory equipment (col. 4, lines 29-30) is communicated to the server on the network (Abstract and col. 4, lines 43-47).

10. Claim 1, lines 9-10, and claim 9 recite correlating the identification of the device with the additional information such as a lifetime of the device.

11. Othmer et al. teaches that the set of data, called a black box, particular to the device includes a timestamp that determines the sequence of events prior to the triggering of a certain event (col. 5, lines 26-30). The sequence of events is "a lifetime" of events of the device.

12. Claim 1, lines 10-12 recites "identification of the medical examination device, wherein the particular additional information relates to an inspection result and a usage record of the medical examination device."

13. Othmer et al. teaches that the timestamp (i.e. additional information) in the black box allows a user to identify events such as a computer crash (col. 5, lines 26-34). The information in

the black box is then sent to the developer who can browse/query the information stored (col. 9, lines 13-21) which is thus also related to the usage of the medical device.

14. Claim 1, lines 13-15, recites sharing and utilizing the information about the device among a plurality of users based on the identification.

15. Othmer et al. teach the sharing and utilizing of the device related information with a plurality of users such as customer service databases, email report generator and query tool (col. 9, lines 5-21). A plurality of users may also include a user receiving solution information and a customer support person (col. 2, lines 57-65).

16. Othmer et al. teach a system and method for monitoring a software application on a set of client computers in order to determine information such as defects of usage patterns wherein the system can be medical laboratory equipment (col. 4, lines 19-35). Othmer et al. however do not teach that the system (i.e. medical device) is DNA chip, as required by claim 1.

17. Nova et al. however teach matrices with memories as platforms for synthesized compounds wherein the data about the matrices can be tracked (Abstract). The matrices may be silicon chips (col. 31, lines 14-19) and chips or arrays that contain probes (col. 31, lines 31-35). The matrix is marked with a code that is stored in memory and contains information regarding the matrix (col. 54, lines 16-30). The information on the code can be accessed by a remote memory (col. 54, lines 31-51).

18. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have implemented the system and method for monitoring a software application on a set of client computers as taught by Othmer et al. to monitor information about DNA microarrays and chips as taught by Nova et al. One of skill in the art would have been

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motivated to use the method of monitoring information taught by Othmer et al. to monitor DNA chips and microarrays because Nova et al. teach the need for retrieving data regarding the medical device (i.e. chip or microarray) at a distance (Nova et al., col. 66, lines 14-40). One of skill in the art would have had a reasonable expectation of success at the method of Othmer et al. with that of Nova et al. because both teach information and data retrieval as applied to medical laboratory equipment (Othmer et al., col. 4, lines 19-35).

RESPONSE TO APPLICANTS

19. Applicant's arguments filed 5/29/2007 have been fully considered but they are not persuasive.

20. Applicants argue (Remarks, page 12, ¶ 5 to page 13, line 2) that there is no indication of motivation that would lead one of ordinary skill in the art to use the matrix of Nova et al. with the software monitoring system of Othmer et al.

21. In response, Othmer et al. teach that their method for monitoring the operation of a computer based systems can be applied to medical laboratory devices (Othmer et al., col. 4, lines 19-35). Additionally Nova et al. teach the need for retrieving data regarding medical devices such as DNA chips (Nova et al., col. 66, lines 14-40). Thus, one of ordinary skill in the art would be motivated to use the identification means as taught by Othmer et al. and apply it to DNA chips as taught by Nova et al.

Conclusion

1. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anna Skibinsky whose telephone number is (571) 272-4373. The examiner can normally be reached on 8 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marjorie Moran can be reached on (571) 272-0720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lori A. Clow/
Primary Patent Examiner
11/20/07